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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,209	10/01/2003	Noel P. Horkan	HOR 101	9682
James Russell Claybrook P. O. Box 843 New Hampton, NY 10958				
7590 05/04/2010				
EXAMINER				
ARYANPOUR, MITRA				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
05/04/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,209

Applicant(s)

HORKAN, NOEL P.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14, 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19, 21-23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19, 21-23 are rejected under 35 USC 101 as being directed to non-statutory subject matter because they are directed to a method or process claim that does not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to a particular machine. *See Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Bilski* 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). Where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101. In this case, "the method of training a player to support a football for kicking by another player" is not considered to be tied to a particular machine because it does not require that the method be implemented by a particular machine. The claimed invention is broad enough to read on a purely mental process. The specification sets forth that the football may use a thimble to hold the football in position. A thimble is not considered by this examiner to qualify as a "particular machine", nor does the thimble transform a particular article. The thimble does not implement the process steps, but is merely a means upon which the process operates.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-14, 19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell et al (5,195,745) in view of Turangan (5,316,294).

Claim 10, Rudell et al shows a combination throwing projectile and glove, the throwing projectile (football 10, 19 or 42) includes two tapered ends and a central section progressively enlarged between the two ends (see figure 1), said projectile having at least one patch (VELCRO tab 44) or alternatively a band of VELCRO (20) attached thereon; and a corresponding one of a full glove (34), a partial glove (60), a wrist strap (28) or a finger band (67) having at least one patch (tab 25, 26; 64, 65; 41; or 88) thereon, the glove is worn by a user. Rundell et al shows the at least one patch is positioned on the object (such as a football) so that when the object is held in typical fashion, there is interaction between the VELCRO on the glove and the VELCRO on the projectile, and wherein the at least one fingerpad of one of said plurality of fingers is positioned adjacent to said pad, said pad having a plurality of mating fastener elements thereon complementary to said mating fastener elements on said at least one patch, said mating fastener elements on said pad releasably engaging said mating fastener elements on said at least one patch. Rudell et al does not expressly disclose the patch being positioned on either of said tapered ends.

Turangan shows a training aid including a football (21) having two tapered ends and a central section progressively enlarged between the two ends (see figure 4), and including at least one patch (strips 54), wherein the at least one patch (strips 54) extends over both tips of said football (see figure 5), said at least one patch having a plurality of male or female mating fastener elements thereon (see column 3, lines 30-34), and a flexible glove (10) having lateral areas positioned adjacent the finger pads (hook fasteners 44) of a user wearing said glove (10); the glove including a plurality of fingers, and at least one positioned on a lateral area of the index finger of said glove (see figure 2). Turangan teaches that it is desirable to include VELCRO over the ends of a football, since a football is typically thrown with its end sections leading, the absence of VELCRO over their end sections has made this type of ball particularly difficult to catch with a mitt (see column 1, lines 30-34). In view of Turangan it would have been obvious to one of ordinary skill in the art at the time the invention was made to have positioned at least one patch on the tip of Rudell et al's football, the motivation being in order to aid in catching the football with a mitt, glove, band etc.

Regarding claim 11, Rudell et al shows said mating fastener elements disengage from said complementary mating elements upon a player handling said football.

Regarding claims 12 and 13, Rudell et al shows said mating elements on said patch or patches comprise hook and loop elements (refer to the figures).

Regarding claim 14, Rudell et al shows the material of said glove is formed of an elastic material, which would include natural and/or synthetic rubber.

Regarding claims 19, 21-23, during normal use and operation of the Rudell et al device, the method steps set forth by applicant in the claim is inherently provided.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Tuesday-Thursday 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mitra Aryanpour/
Primary Examiner, Art Unit 3711